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09/303,632

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EXAMINER

EVANISKO, LESLIE J

ART UNIT

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/303,632
Filing Date: May 03, 1999
Appellant(s): LEBEAU ET AL.

MAILED

AUG 11 2004

GROUP 2800

Arthur G. Yeager
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed April 29, 2004.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

No amendment after final has been filed.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is substantially correct. The changes are as follows: Issue E. on page 4 of the appeal brief should read: --Whether Claims 22-23 are obvious over Yanagisawa in view of

Adair and the IBM reference as applied to claims 21 and 24-26 above, and further in view of either Okamura or Young?--.

(7) *Grouping of Claims*

The rejection of claims 21 and 24-26 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

The rejection of claims 22-23 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

The rejection of claims 28-30 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

The rejection of claims 32 and 35-37 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

The rejection of claims 33-34 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

The rejection of claims 41 and 42 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

| | | |
|----------------|---------------|---------|
| 5,397,182 | GAIBLE et al. | 03-1995 |
| 5,872,527 | YANAGISAWA | 02-1999 |
| 5,812,188 | ADAIR | 09-1998 |
| 5,089,690 | OKAMURA | 02-1992 |
| GB 2 201 922 A | YOUNG | 09-1988 |

"Conformal Cover for a Handheld Computer Unit"; IBM Technical Disclosure Bulletin, Vol. 37, Issue 6B; (June 1, 1994), pages 125-126

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 32, 35-37, and 41-42 are rejected under 35 U.S.C. 102(b) as being anticipated by Gaible et al. (US 5,397,182). Gaible et al. teach an individual transparent bag or “cover” comprising a pair of identical flat and “entirely” transparent planar sheets of pliable plastic film of uniform thickness “throughout” being fastened along at least a bottom edge so as to be capable of enveloping entire upper and bottom surfaces of a keyboard. See Figure 2 and column 4, lines 34-38 of Gaible et al.

Note that although Gaible et al. do not necessarily teach the cover is used for covering a keyboard, note that the claim is drawn to the cover structure per se and not the combination of the cover and keyboard. Therefore, the claim language regarding how the cover is used is merely the intended use of the cover and has no patentable significance to the claims.

Thus, Gaible et al. teach a "cover" including all of the structure limitations as recited.

With respect to claim 37, note that Gaible et al. teach a sheet formed as an envelope with an elongated opening along a top edge portion as broadly recited.

With respect to claim 42, note that Gaible et al. teaches the two flat sheets are fastened together along each side edge portion with an opening along the top edge portion as recited.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 32 and 35-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yanagisawa (US 5,872,527) in view of Adair (US 5,812,188). Yanagisawa teaches an individual disposable transparent cover **34, 34'** comprising a flat and entirely transparent planar sheet of pliable film of uniform thickness throughout and a predetermined size in length and width for covering a keyboard as recited. See Figures 9-10 and column 11, lines 21-67

in particular. Note that although Yanagisawa does not specifically state that the cover is a plastic film as recited, note that Adair teaches the use of flexible transparent materials such as polyurethane, polyolefins, and laminated plastic films for a covering for a keyboard in a sterile environment is well known in the art. See Figures 1 and 5 and column 5, lines 2-16 and column 6, lines 38-55. In view of this teaching, it would have been obvious to one of ordinary skill in the art to use a plastic film as taught by Adair for the flexible transparent film of cover of Yanagisawa as it would require simply the obvious selection of a known material based upon its known properties.

With respect to claim 35, note Yanagisawa teaches the cover may comprise an enclosure for enclosing the entire keyboard body in column 11, lines 36-37.

With respect to claim 36, note that Adair teaches the use of a cover member which comprises an upper member adapted to overlie the upper surface of a keyboard and a lower member adapted to underlie a bottom surface of a keyboard to completely enclose both the upper and bottom surfaces of a keyboard. Again, note Figure 5 in particular. In view of this teaching, it would have been obvious to one of ordinary skill in the art to provide an upper and lower member on the sheet as taught by Adair to provide the cover of Yanagisawa to completely enclose the keyboard as desired.

With respect to claim 37, note Adair teaches a sheet formed as an envelope with an elongated opening along a top edge portion as broadly recited.

Again, it would have been obvious to one of ordinary skill in the art to use the particular sheet configuration as taught by Adair for the cover of Yanagisawa to provide an enclosure for use in a sterile environment with an opening for allowing insertion of the keyboard inside the enclosure.

5. Claims 33-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yanagisawa (US 5,872,527) in view of Adair as applied to claims 32 and 35-37 above, and further in view of either of Okamura (US 5,089,690) or Young (GB 2 201 922 A). Yanagisawa in view of Adair teach a transparent cover as recited with the exception of the sheet including strips of adhesive along either or both of a top edge and bottom edge of the sheet. Note that Yanagisawa does teach the cover member includes attachment means for removably attaching the cover to the underlying keyboard in column 11, lines 24-29 and 34-36. Although the attachment means of Yanagisawa is not adhesive strips, note that the use of adhesive strips to attach a keyboard cover to a keyboard is well known in the art as exemplified by the teachings of both Okamura and Young. See Figure 2 and column 3, lines 1-16 of Okamura and Figures 1B-1C and claims 1-2 of Young in particular. In view of these teachings, it would have been obvious to one of ordinary skill in the art to use adhesive strips as taught by each of Young and Okamura in the transparent cover of Yanagisawa, as it would require simply the obvious substitution of one known fastening means

for another to provide secure attachment of the removable cover to the underlying keyboard.

6. Claims 21 and 24-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yanagisawa (US 5,872,527) in view of Adair (US 5,812,188) and IBM Technical Disclosure Bulletin, June 1994, Vol. 37, Issue 6B, pages 125-126. (referred to hereafter as the IBM reference). Yanagisawa teaches an individual disposable transparent cover **34, 34'** comprising a flat and entirely transparent planar sheet of pliable film of uniform thickness throughout and a predetermined size in length and width for covering a keyboard as recited. See Figures 9-10 and column 11, lines 21-67 in particular. Note that although Yanagisawa does not specifically state that the cover is a plastic film as recited, note that Adair teaches the use of flexible transparent materials such as polyurethane, polyolefins, and laminated plastic films for a covering for a keyboard in a sterile environment is well known in the art. See Figures 1 and 5 and column 5, lines 2-16 and column 6, lines 38-55. In view of this teaching, it would have been obvious to one of ordinary skill in the art to use a plastic film as taught by Adair for the flexible transparent film of cover of Yanagisawa as it would require simply the obvious selection of a known material based upon its known properties.

Furthermore, note that although Yanagisawa teaches the covers are disposable and replaceable in column 11, lines 61-67, Yanagisawa is silent

with respect to whether a plurality of these covers are provided in a package. However, the provision of a plurality of disposable items in a package is well known in the art as exemplified by commercially available packages of such disposable items as sandwich bags, trash bags, etc. Furthermore, the IBM reference teaches packs of individual disposable covers for covering handheld computer devices in the fourth paragraph on page 126. In view of this teaching, it would have been obvious to one of ordinary skill in the art to provide a pack having a plurality of the replaceable film cover of Yanagisawa as modified by Adair to facilitate discarding and replacing the covers as they become soiled or damaged.

With respect to claims 24-25, note the above comments with respect to claims 35-36.

With respect to claim 26, note the above comments with respect to claim 37.

7. Claims 22-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yanagisawa (US 5,872,527) in view of Adair and the IBM reference as applied to claims 21 and 24-26 above, and further in view of either of Okamura (US 5,089,690) or Young (GB 2 201 922). Yanagisawa in view of Adair and the IBM reference teach a package of individual disposable transparent covers as recited with the exception of the transparent cover including strips of adhesive along either or both of a top edge and bottom edge of the sheet. Note that

Yanagisawa does teach the cover member includes attachment means for removably attaching the cover to the underlying keyboard in column 11, lines 24-29 and 34-36. Although the attachment means of Yanagisawa is not adhesive strips, note that the use of adhesive strips to attach a keyboard cover to a keyboard is well known in the art as exemplified by the teachings of both Okamura and Young. See Figure 2 and column 3, lines 1-16 of Okamura and Figures 1B-1C and claims 1-2 of Young in particular. In view of these teachings, it would have been obvious to one of ordinary skill in the art to use adhesive strips as taught by each of Young and Okamura in the transparent cover of Yanagisawa as modified by Adair and the IBM reference, as it would require simply the obvious substitution of one known fastening means for another to provide secure attachment of the removable cover to the underlying keyboard.

8. Claims 21, 24-26, and 28-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gaible et al. (US 5,397,182) in view of the IBM reference. Gaible et al. teach an individual transparent bag or "cover" comprising a pair of identical flat and entirely transparent planar sheets of uniform thickness pliable plastic film being fastened along at least a bottom edge so as to envelope entire upper and bottom surfaces of a keyboard within the enclosure formed by the upper and lower sheet members. See Figure 2 and column 4, lines 34-38 of Gaible et al.

Note that although Gaible et al. do not necessarily teach the cover is used for covering a keyboard, note that the claim is drawn to the cover structure per se and not the combination of the cover and keyboard. Therefore, the claim language regarding how the cover is used is merely the intended use of the cover and has no patentable significance to the claims. Thus, Gaible et al. teach a "cover" including all of the structure as recited.

Furthermore, although Gaible et al. is silent with respect to whether it includes a package containing a plurality of such bags, the provision of a plurality of disposable items in a package is well known in the art as exemplified by commercially available packages of such disposable items as sandwich bags, trash bags, etc. Furthermore, the IBM reference teaches packs of individual disposable covers for covering handheld computer devices in the fourth paragraph on page 126. In view of this teaching, it would have been obvious to one of ordinary skill in the art to provide a pack having a plurality of the bags of Gaible et al. to facilitate discarding and replacing the covers as they become soiled or damaged.

With respect to claims 29-30, note that Gaible et al. teaches the two flat sheets are fastened together along each side edge portion with an opening along the top edge portion as recited.

With respect to claim 30, to the extent applicant has defined which edge portions are which, note that depending upon the orientation of the cover and the viewing direction in which a user views the cover, the left and right edges of

the bag illustrated in Figure 2 can be considered as the upper and lower edges as recited. Regardless, it would have been obvious to one of ordinary skill in the art to provide any three sides of the bag to be sealed to provide an enclosure for covering a keyboard.

(11) Response to Argument

Applicant's arguments with respect to claims 21-26, 28-30, 32-37, and 41-42 have been considered but they are not persuasive of any error in the above rejections.

RESPONSE TO SECTION A IN BRIEF:

In particular, applicant argues that Gaible et al. does not teach an entirely transparent planar sheet of pliable plastic film which has a uniform thickness throughout because the cover member of Gaible et al. includes an opaque web portion and write on portion. However, the Examiner disagrees with this argument. In particular, it is the Examiner's position that the cover of Gaible et al. includes two identical flat transparent sheets of pliable plastic film 32a, 32b as recited. As taught by Gaible et al. in column 4, lines 34-52, the two webs 228, 230 (which includes the opaque portion and locking members 224, 226 applicant refers to) are separate members that are attached to the ends of the two flat and transparent sheets of plastic film 32a, 32b.

Applicant also argues that there is no indication that the storage bag of Gaible et al. is usable to envelope the entire upper and bottom surfaces of a keyboard without impeding an operator's ability to manipulate the keyboard. In fact, applicant goes on to argue that the plastic of Gaible et al. is not sufficiently pliable to permit typing depression of the keys of the keyboard. The Examiner disagrees with this argument. In particular, the storage bag of Gaible et al. is broadly capable of being used to envelope the upper and lower surfaces of a keyboard and the flexible bag material is capable of permitting a user to depress keys of a keyboard. Again, the Examiner points out that the claims are drawn to a cover per se and not the combination of a cover and keyboard. Therefore, since Gaible et al. provides all of the structural elements as recited and is broadly capable of being used in the manner recited, it meets the claim language.

RESPONSE TO SECTION B IN BRIEF:

Additionally, applicant argues that Yanagisawa fails to teach a keyboard cover including a flat entirely planar sheet of uniform thickness throughout since the cover includes elastic band fastening members on the ends of the sheet. Again, the Examiner disagrees with this argument. Although Yanagisawa does teach the keyboard cover is provided with rubber band elements for fastening the cover to the keyboard in column 11, lines 21-35, it is the Examiner's position that these rubber band elements are not necessarily

integrally formed in the thin cover, but merely an attachment to the thin cover of uniform thickness throughout. This is similar to applicant's own disclosed covers, which include various types of fastening members attached to the end portion of at least one of the identical sheets of uniform thickness throughout (see page 5, lines 7-9, and page 6, lines 8-12 of the specification).

Furthermore, applicant argues that Yanagisawa and Adair are not properly combinable since Yanagisawa is drawn to a sheet held in place by rubber bands while Adair is drawn to a bag for enveloping a keyboard. Again, the Examiner disagrees with this argument. Firstly, note that Yanagisawa teaches that, alternative to what is shown in Figure 10, the entire keyboard body 21 may be covered to be enclosed. (column 11, lines 36-37). This provides one of ordinary skill in the art with a motivation to look at the teaching of Adair, which provides a bag-like structure to completely enclose a keyboard.

Furthermore, note that it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, since both Yanagisawa and Adair are concerned with providing a protective cover for a keyboard, they are considered to be in the field of applicant's endeavor, or at least reasonably pertinent to the problem with which applicant is concerned (i.e., preventing contamination of a keyboard). Therefore, Adair and

Yanagisawa are considered to be analogous and their teachings to be properly combinable.

Applicant also argues that Adair fails to teach an elongated opening as recited since the opening is rolled up and taped shut. The Examiner disagrees. An opening is still an opening regardless of whether it is sealed shut or not. The opening of Adair still allows for the keyboard to be placed in or removed from the cover structure.

RESPONSE TO SECTION C IN BRIEF:

Applicant also argues that the teachings of Okamura and Young are not properly combinable with the teachings of Yanagisawa in view of Adair since each of Okamura and Young are drawn to rigid keyboard covers and Yanagisawa and Adair are drawn to pliable film covers. The Examiner disagrees with this argument. Note that it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, all of Yanagisawa, Adair, Okamura, and Young are concerned with providing a protective cover for a keyboard or keypad, which is at least reasonably pertinent to the problem with which applicant is concerned, and

therefore are considered to be analogous and their teachings to be properly combinable.

Applicant also argues that the bag of Adair does not teach or suggest the use of adhesive tape to attach the bag to a keyboard. The Examiner points out that Adair is not being relied upon for its teaching of adhesive tape since Okamura and Young are relied upon for that teaching. Therefore, the fact that the adhesive tape is Adair is being used for a different purpose is irrelevant.

RESPONSE TO SECTION D IN BRIEF:

Applicant also argues that the IBM reference bears no resemblance to the sheet recited in claim 21. Again, the Examiner points out that the IBM reference is being relied upon to show that providing packages of disposable protective covers for keyboard devices is well known in the art. The fact that the cover in the IBM reference is somewhat different from the recited cover is irrelevant, since Yanagisawa and Adair are relied upon to teach the cover as recited.

RESPONSE TO SECTION E AND F IN BRIEF:

Note the above comments with respect to sections A-D since applicant does not provide any particular separate arguments for these rejections.

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In view of the above reasons, the Examiner is not persuaded of any error in the applied rejections.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



Leslie J. Evanisko

Primary Examiner

Art Unit 2854

lje


July 23, 2004

Conferees



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